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Technology Center 2100

In re Application of:
Guerney D. H. Hunt et al.
Application No. 10/650,107
Filed: August 26, 2003
For: TIME-BASED MULTI-TIER MANAGEMENT
OF RESURCE SYSTEM

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)
) **DECISION ON PETITION**
) **UNDER 37 CFR § 1.181**
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This is decision a on the petition under 37 C.F.R. § 1.181 for Withdrawal of Finality filed February 4, 2008.

The petition is **DENIED**.

Claims 1-34 were rejected in a non-final rejection mailed on May 25, 2007. In that action, claims 1-10, 12-22, and 24-33 are rejected under 35 USC 103 (a) as being upatentable over "Tivoli Storage Network Manger" (hereinafter Tivoli) in view of "The Use Of Life Expectancy To Manage Lotus Notes Email Storage" by William G. Pope (hereinafter Bucky). Claims 11, 23, and 34 were rejected under Tivoli in view of Bucky and further in view of "Advances IN Windows NT Storage management "(hereinafter NT). In his response to this action, Petitioner canceled claims 6, 18, and 29. Claims 1-2, 7, 11-13, 19, 24-28, 30, 31 and 34 were amended.

In the Office Action mailed on November 02, 2007, the examiner finally rejected claims 1-5, 7-17, 19-28, and 30-34. Claims 1-5, 7-10, 12-17, 19-22, 24-28, and 30-33 are finally rejected under 35 USC 103 (a) as being upatentable over Tivoli in view of Bucky. Claims 11, 23, and 34 were rejected under Tivoli in view of Bucky and further in view of Styszinski (US Patent No. 5960169).

In the petition filed on February 4, 2008, Petitioner asserts two basis for his request to withdraw finality of the November 2007 action. First, Petitioner alleges that the final rejection is premature in that a different passage of Bucky was cited as a basis for the rejection of unamended claim 9 than was presented in the prior non-final action of May 2007. Secondly, Petitioner urges that application of Styszinski (US Patent No. 5960169) applied for the first time as a basis of the rejection of claim 11 requires that November 2007 action be made non-final.

(1) The Final Rejection of Claim 9 is premature.

To buttress his position, Petitioner directs attention to a series of cases including *In re Kronig*, 190 USPQ 425 (CCPA 1976). As noted by Petitioner, the PTO follows rationale for identifying a new grounds of rejection provided in the *Kronig* decision.

MPEP 1207.03 III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

The statutory basis for the rejection of claim 9 in both the final and non-final rejections is 35 USC 103. In both actions, the evidence relied upon is "The Use Of Life Expectancy To Manage Lotus Notes Email Storage" by William G. Pope (Bucky). In this case, the examiner modified his rationale in support of the rejection but did not change the evidence or statutory basis. Thus, as indicated in section 1207.03 reproduced above, this modification does not necessarily constitute a new ground of rejection.

(2) Use of A Styczinski To Reject Claim 11 Requires Withdrawal of Finality of the Action

As a second basis for his request to withdraw finality, Petitioner notes that *Styczinski* (US Patent No. 5960169) was applied for the first time in the rejection of claim 11 in the November 2007 action. Petitioner alleges that application the new reference was not necessitated by an amendment "since the claim limitations rejected in the Final Office Action were not changed".

As noted in MPEP 706.07(a),

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

A review of the record, including page 2 of the petition, indicates that claim 11 was in fact amended in response to the non-final Office Action of May 2007. Thus, application of the new reference was warranted.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3591.

/Gail O. Hayes/
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